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Case No. EP 7041 Div.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Vincent James Gatto

Serial No.: 09/604,285

Filed: 06/26/00

For: LUBRICANT CONTAINING MOLYBDENUM
COMPOUND AND SECONDARY DIARYLAMINE

Ethyl Corporation
330 South 4th Street
Richmond, VA 23219

I hereby certify that this correspondence is
being deposited with the United States Postal
Service as first class mail in an envelope
addressed to:

Assistant Commissioner of Patents,
Box Missing Parts
Washington, D.C. 20231 October 10, 2000.

Hope M. Pettis
Name of Applicant, Assignee or Registered
Representative
[Signature]
Signature
Hope M. Pettis
Date of Signature

COMMUNICATION

Assistant Commissioner of Patents
Washington, D.C. 20231

Sir:

Enclosed herewith is a copy of the "Notice to File Missing Parts of Nonprovisional
Application" dated September 12, 2000, on the above application, one Declaration duly signed
by the inventor and making reference to the serial number and filing date given on such "Notice".

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UNITED STATES PATENT AND TRADEMARK OFFICE

 COMMISSIONER FOR PATENTS
 UNITED STATES PATENT AND TRADEMARK OFFICE
 WASHINGTON, D.C. 20231
 www.uspto.gov

| APPLICATION NUMBER | FILING/RECEIPT DATE | FIRST NAMED APPLICANT | ATTORNEY DOCKET NUMBER |
|--------------------|---------------------|-----------------------|------------------------|
| 09/604,285 | 06/26/2000 | Vincent James Gatto | PM 268477 |

FORMALITIES LETTER



OC000000005392655

 Intellectual Property Group of
 Pillsbury Madison & Sutro LLP
 Ninth Floor East Tower
 1100 New York Avenue NW
 Washington, DC 20005-3918

Date Mailed: 09/12/2000

RECEIVED

APR -3 2001

OIP/JCWS

NOTICE TO FILE MISSING PARTS OF NONPROVISIONAL APPLICATION

FILED UNDER 37 CFR 1.53(b)

Filing Date Granted

An application number and filing date have been accorded to this application. The item(s) indicated below, however, are missing. Applicant is given TWO MONTHS from the date of this Notice within which to file all required items and pay any fees required below to avoid abandonment. Extensions of time may be obtained by filing a petition accompanied by the extension fee under the provisions of 37 CFR 1.136(a).

- The statutory basic filing fee is missing.
Applicant must submit \$ 690 to complete the basic filing fee and/or file a small entity statement claiming such status (37 CFR 1.27).
- Total additional claim fee(s) for this application is \$756.
 - \$756 for 42 total claims over 20.
- The oath or declaration is missing.
A properly signed oath or declaration in compliance with 37 CFR 1.63, identifying the application by the above Application Number and Filing Date, is required.
- To avoid abandonment, a late filing fee or oath or declaration surcharge as set forth in 37 CFR 1.16(e) of \$130 for a non-small entity, must be submitted with the missing items identified in this letter.
- The balance due by applicant is \$ 1576.

A copy of this notice MUST be returned with the reply.

Customer Service Center

Initial Patent Examination Division (703) 308-1202

PART 1 - ATTORNEY/APPLICANT COPY

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 Adjustment date: 04/03/2001 SSANDARA 00000002 09604285
 10/16/2000 HUONGI 00000009 051372

 01 FC:108 710.00 CR
 02 FC:105 130.00 CR
 03 FC:104 756.00 CR

2/00

04/03/2001 SSANDARA 00000002 09604285

 710.00 DP
 756.00 DP
 130.00 DP
 1576.00 DP

 01 FC:108
 02 FC:105
 03 FC:105
 04 FC:104

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EP-7041-Div.

PTO/SB/17 (09-00)

Approved for use through 10/31/2002. OMB 0651-0032
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

**FEE TRANSMITTAL
for FY 2001**

Patent fees are subject to annual revision.

TOTAL AMOUNT OF PAYMENT (\$) 1576**Complete if Known**

| | |
|----------------------|---------------------|
| Application Number | 09/604,285 |
| Filing Date | 06/26/00 |
| First Named Inventor | Vincent James Gatto |
| Examiner Name | Bobbie Davenport |
| Group Art Unit | 1714 |
| Attorney Docket No. | EP-7041-Div. |

METHOD OF PAYMENT

- 1.
- ☒
- The Commissioner is hereby authorized to charge indicated fees and credit any overpayments to:

| | |
|------------------------|-------------------|
| Deposit Account Number | 05-1372 |
| Deposit Account Name | Ethyl Corporation |

- ☒
- Charge Any Additional Fee Required Under 37 CFR 1.16 and 1.17

☐ Applicant claims small entity status. See 37 CFR 1.27

- 2.
- ☐
- Payment Enclosed:

☐ Check ☐ Credit card ☐ Money Order ☐ Other**FEE CALCULATION****1. BASIC FILING FEE**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|------------------------|----------|
| 101 710 | 201 355 | Utility filing fee | 690 |
| 106 320 | 206 160 | Design filing fee | |
| 107 490 | 207 245 | Plant filing fee | |
| 108 710 | 208 355 | Reissue filing fee | |
| 114 150 | 214 75 | Provisional filing fee | |

SUBTOTAL (1) (\$) 690**2. EXTRA CLAIM FEES**

| Total Claims | Extra Claims | Fee from below | Fee Paid |
|--------------------|--------------|----------------|----------|
| 62 | -20** = 42 | 18 | 756 |
| Independent Claims | -3** = | | |
| Multiple Dependent | | | |

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description |
|----------------------------|----------------------------|--|
| 103 18 | 203 9 | Claims in excess of 20 |
| 102 80 | 202 40 | Independent claims in excess of 3 |
| 104 270 | 204 135 | Multiple dependent claim, if not paid |
| 109 80 | 209 40 | ** Reissue independent claims over original patent |
| 110 18 | 210 9 | ** Reissue claims in excess of 20 and over original patent |

SUBTOTAL (2) (\$) 756

**for number previously paid, if greater; For Reissues, see above

FEE CALCULATION (continued)**3. ADDITIONAL FEES**

| Large Entity Fee Code (\$) | Small Entity Fee Code (\$) | Fee Description | Fee Paid |
|----------------------------|----------------------------|--|----------|
| 105 130 | 205 65 | Surcharge - late filing fee or oath | 130.00 |
| 127 50 | 227 25 | Surcharge - late provisional filing fee or cover sheet | |
| 139 130 | 139 130 | Non-English specification | |
| 147 2,520 | 147 2,520 | For filing a request for <i>ex parte</i> reexamination | |
| 112 920* | 112 920* | Requesting publication of SIR prior to Examiner action | |
| 113 1,840* | 113 1,840* | Requesting publication of SIR after Examiner action | |
| 115 110 | 215 55 | Extension for reply within first month | |
| 116 390 | 216 195 | Extension for reply within second month | |
| 117 890 | 217 445 | Extension for reply within third month | |
| 118 1,390 | 218 695 | Extension for reply within fourth month | |
| 128 1,890 | 228 945 | Extension for reply within fifth month | |
| 119 310 | 219 155 | Notice of Appeal | |
| 120 310 | 220 155 | Filing a brief in support of an appeal | |
| 121 270 | 221 135 | Request for oral hearing | |
| 138 1,510 | 138 1,510 | Petition to institute a public use proceeding | |
| 140 110 | 240 55 | Petition to revive - unavoidable | |
| 141 1,240 | 241 620 | Petition to revive - unintentional | |
| 142 1,240 | 242 620 | Utility issue fee (or reissue) | |
| 143 440 | 243 220 | Design issue fee | |
| 144 600 | 244 300 | Plant issue fee | |
| 122 130 | 122 130 | Petitions to the Commissioner | |
| 123 50 | 123 50 | Petitions related to provisional applications | |
| 126 240 | 126 240 | Submission of Information Disclosure Stmt | |
| 581 40 | 581 40 | Recording each patent assignment per property (times number of properties) | |
| 146 710 | 246 355 | Filing a submission after final rejection (37 CFR § 1.129(a)) | |
| 149 710 | 249 355 | For each additional invention to be examined (37 CFR § 1.129(b)) | |
| 179 710 | 279 355 | Request for Continued Examination (RCE) | |
| 169 900 | 169 900 | Request for expedited examination of a design application | |

Other fee (specify) _____

* Reduced by Basic Filing Fee Paid

SUBTOTAL (3) (\$) 130.00**SUBMITTED BY**

| | | | | | |
|-------------------|--------------------------|-----------------------------------|----------|-----------|--------------|
| Name (Print/Type) | Dennis H. Rainear | Registration No. (Attorney/Agent) | 32,486 | Telephone | 804-788-5516 |
| Signature | <i>Dennis H. Rainear</i> | Date | 10/29/00 | | |

WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231.

#6/ Dec 17-01
H. Butler

GATTO, et al.

Examiner: Margaret B. Medley

Appln. No.: 09/604,285

Filed: June 26, 2000

FOR: LUBRICANT CONTAINING MOLYBDENUM
COMPOUND AND SECONDARY DIARYLAMINE

* * * * *

CONTINUATION DECLARATION FOR REISSUE APPLICATION

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

BEST AVAILABLE COPY

Sir:

1. Vincent James Gatto and Mark Thomas Devlin each individually declare that our residence, post office address and citizenship are as respectively stated below next to our names and that we each verily believe we are the original joint and first inventors of the invention entitled Lubricant Containing Molybdenum and Secondary Diarylamine described and claimed in Letters Patent No. 5,650,381, issued on July 22, 1997 from our original application, serial number 08/559,879 filed on November 20, 1995, that I do know and do not believe that this invention was ever known or used in the United States before our invention thereof, or patented or described in any publication in any country before our invention thereof, or more than one year prior to our original application, or in public use or on sale in the United States more than one year prior to our original application; that our invention had not been patented or made the subject of an inventor's certificate in any country foreign to the United States prior to the date of our original U.S. application number 08/559,879 on an application filed by me or my legal representatives or assigns more than twelve months before our said original application; and that I

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ation; and that I

believe our original U.S. Patent No. 5,650,381 to be partly inoperative or invalid by the reasons of our claiming more or less than we had a right to claim, which occurred without deceptive intention, and for which reason we filed this continuation application to continue patent prosecution of certain claims or their substantial counterparts from parent reissue application 09/359,770.

2. I hereby claim foreign priority benefits under 35 U.S.C. §119/365 of any foreign application(s) for patent or inventor(s) certificate listed hereinbelow and have also identified below any foreign patent application for patent or inventor(s) certificate filed by me or my assignee disclosing the subject matter claimed in this application and having a filing date (1) before that of the application on which priority is claimed, or (2) if no priority is claimed, before the filing date of this application: None

3. I hereby claim domestic priority benefit under 35 U.S.C. 119/120/365 of the United States reissue application No. 09/359,770 filed July 22, 1999, now pending, as this application is a continuation thereof, and United States application No. 08/559,879 filed November 20, 1995.

4. I have reviewed and understand the contents of the above-identified specification in paragraph 1, and our continuation application for reissue filed on June 26, 2000.

5. I acknowledge that the original patent has been assigned to Ethyl Corporation. I am informed that my assignment was recorded in the assignment branch of the U.S. Patent and Trademark Office on Reel 8380 at Frame 0823.

6. As stated herein in paragraph 1, I believe that our original U.S. Patent No. 5,656,381 contains an error(s) which occurred without deceptive intention. The error(s) was discovered after reviewing the claims of U.S. Patent No. 5,840,672, assigned to Ethyl Corporation.

7. After studying the claims of U.S. Patent No. 5,840,672, I recognized for the first

time that the claims of U.S. Patent No. 5,650,381 contain an error in that we claimed less we had a right to claim.

8. After reviewing the U.S. Patent No. 5,840,672, and upon further reviewing the issued claims in U.S. Patent No. 5,650,381, I recognized for the first time that the relative amounts of the molybdenum compound and secondary diarylamine may not have the scope as we were entitled.

9. On information and belief original claims 1-21 in our U.S. Patent No. 5,650,381 have been held allowable, as has a further method claim to be renumbered as claim 22, in our parent reissue application 09/359,770. On information and belief the claims presented herein (or substantially the same claims) were also presented in our parent reissue application, filed July 22, 1999, but were later canceled without prejudice from our parent reissue application. We filed the claims herein in our reissue continuation application 09/604,285 for the reasons stated herein above in paragraph 1.

10. New independent claims 22 and 23 herein define lubricating compositions in which the amounts of one recited ingredient versus the other are based on the weight ratios disclosed in our specification at column 6, lines 46-50. I believe that our new claims 22-23 ensure that the subject matter of our invention is better recited and avoids the mistake recounted in paragraphs 1-7 supra.

11. New dependent claim 24 recites the oil soluble molybdenum compound is substantially free of sulfur consistent with column 3, lines 36-40 and column 8, last two lines of the originally filed specification. This embodiment is not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have in U.S. Patent No. 5,650,381, and therefore claim 24 has been included in our continuation application to reissue the aforesaid U.S. Patent.

12. New claims 25-29 and 31-40 in our reissue continuation application are dependent upon new independent claims 22 or 23. With the submission of only a new claims 22 and 23, I realize

that we would still not be claiming all that we could have, and therefore claims 25-29 and 31-32 have been included in our reissue application, consistent with new claims 22 and 23 and in view of column 2, Summary of the Invention; and column 5, lines 49-63.

13. New claims 25 to 29 in our reissue application are dependent upon new claims 22 and 23. With the submission of only new claims 22 and 23, I realize that we would still not be claiming all that we could have been in U.S. Patent No. 5,650,381, and therefore claims 25 to 29 have been included in our application to reissue the aforesaid U.S. Patent.

14. New dependent claim 30 recites species of the molybdenum compound which is disclosed in the present specification at column 10, Example 2 (molybdenum naphthenate), column 13, Example 4 (molybdenum octoate), and column 14, Example 5 (molybdenum 2-ethylhexanoate). These species as in claim 30 were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have in U.S. Patent No. 5,650,381, and therefore dependent claim 30 has been included in our application to reissue the aforesaid U.S. Patent.

15. New dependent claims 31-40 recite more particularly the molybdenum compound consistent with the disclosures at column 3, lines 48-54; column 5, lines 49-63; column 5, lines 3-26; column 3, lines 60-61; column 4, last 6 lines to column 5, lines 1-2 of the present specification. These embodiments defined by dependent claims 31-40, in combination with new claims 22 or 23, were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have in U.S. Patent No. 5,650,381, and therefore claims 31-40 depending from claims 22 or 23 have been included in our application to reissue the aforesaid U.S. patent.

16. New claim 41 depends upon new claims 22 or 23. The embodiment defined by claim

41, in combination with new reissue claims 22 or 23, was not specifically claimed in U.S. Patent No.

5,650,381, but could have been. New claim 41 relates to column 4. We did not claim all that we could have in U.S. Patent No. 5,650,381, and therefore new claim 41 has been included in our continuation application to reissue the aforesaid U.S. patent.

17. New claims 42-44 also defines the oil soluble molybdenum compound in claims 22 or 23. New claim 42 relates to the Examples and column 4. New claim 43 relates to the specification at column 4, numbered paragraph 3. New claim 44 relates to the specification at column 4, at numbered paragraph 4. The embodiments defined by dependent claims 42-47 were not specifically claimed in U.S. Patent No. 5,650,381, but could have been. We did not claim all that we could have claimed in U.S. Patent No. 5,560,381, and therefore new dependent claims 42-44 have been included in our reissue application.

18. New claim 45 depends from new claims 22 or 23 and defines the secondary diarylamine as disclosed in the present specification at column 6, lines 1-15.

19. New claim 46, depends from new claims 22 or 23 and recites that the secondary diarylamine is of the formula per column 6, lines 1-15.

20. New claim 47 depends from claim 46 and relates to column 6, sixth line after the formula.

21. New claim 48 depends from new claim 46, and defines the aryl groups per column 6, lines 1-15.

22. New claim 49 depends from new claim 46 and defines the aryl groups according to column 6, lines 1-15.

23. New claim 50 depends from new claim 46 and recites the lubricating composition can include an additive according to column 8, lines 21-23. New dependent claim 50, in combination with

claims 22 or 23, could have been claimed in U.S. Patent No. 5,650,381, and has therefore been included in our reissue continuation application.

24. New independent claim 52 is directed to our method of obtaining a lubricant having improved antioxidancy and friction properties consistent with column 2, Summary of the Invention. This new claim could have been claimed in U.S. Patent No. 5,650,381, and is therefore included in our reissue continuation application.

25. New claim 53 is directed to a method for lubricating an automotive or truck crankcase or transmission with a composition according to claim 22 or 23. New claim 54 relates to one or more of the utilities recited at column 3, lines 9-11, column 7, lines 52-55, column 8, penultimate paragraph. It could have been claimed in U.S. Patent No. 5,650,381, and has therefore been included in our reissue application.

26. New claim 54 recites a lubricated crankcase or transmission obtained by method of new claim 50 consistent with the disclosure at column 3, lines 9-11, column 6, line 27, column 7, lines 52-55, column 8, penultimate paragraph. Since this could have been claimed in U.S. Patent No. 5,650,381, it has been included in our reissue application.

27. As stated herein, we claimed less than we had a right to claim in U.S. Patent No. 5,650,381 and for this reason presented the further claims 22-54. The failure to claim all that we could have claimed was first appreciated by me upon reviewing the claims in U.S. Patent No. 5,650,381 in view of the hereinabove mentioned U.S. Patent No. 5,840,672. The failure to claim all that we could have claimed was an error and constitutes an insufficiency in the claims in U.S. Patent No. 5,650,381. This error(s) was without deceptive intention.

28. On information and belief, U.S. Patent No. 5,650,381 is not involved in any litigation or declared interference. On information and belief certain claims in our U.S. Patent No.

5,650,381 were the subject of a request for reexamination, granted merged with our parent reissue application 09/359,770. On information and belief all original claims 1-21 and a method to be renumbered as claim 22 in said merged reissue have been or will be held allowable.

29. WHEREFOR I PRAY that we each may be allowed to rely upon the surrender of our said U.S. Letters Patent No. 5,650,381 in the parent application 09/359,770 to reissue said U.S. Letters Patent, and pray that such surrender, now made therein, suffices for this continuation application wherefore a Reissue Letters Patent may be issued for the inventions described by the foregoing claims in the present continuation application.

30. I acknowledge the duty to disclose all information known to me to be material to patentability as defined in 37 C.F.R. 1.56 to the claims submitted in my reissue application.

31. I HEREBY DECLARE that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that the statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of this reissue application or any patent issued thereon.

(1) INVENTOR'S SIGNATURE:

Vince James Gatto

Date: *Dec. 12, 2000*

| | | | | | |
|---------------------|------------|--|----------|------------------------|---------------|
| Vince | | James | | GATTO | |
| First | | Middle Initial | | Family Name | |
| Residence | Midlothian | | Virginia | | United States |
| City | | State/Foreign Country | | Country of Citizenship | |
| Post Office Address | | 13709 West Bay Drive, Midlothian, Virginia | | | |
| (include Zip Code) | | 23112 | | | |

(2) INVENTOR'S SIGNATURE:

Mark Thomas Devlin

Date: *Dec 12, 2000*

| | | | | | |
|---------------------|----------|---|----------|------------------------|---------------|
| Mark | | Thomas | | DEVLIN | |
| First | | Middle Initial | | Family Name | |
| Residence | Richmond | | Virginia | | United States |
| City | | State/Foreign Country | | Country of Citizenship | |
| Post Office Address | | 13312 Herring Bone Place Richmond, Virginia | | | |
| (include Zip Code) | | 23233 | | | |